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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,559	02/06/2004	Hiromichi Kobayashi	1217-040223	3556

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THE WEBB LAW FIRM, P.C.  
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EXAMINER
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LE, HOA VAN

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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11/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/773,559	Applicant(s) KOBAYASHI ET AL.	
	Examiner Hoa V. Le	Art Unit 1795	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19, 21-38 and 40-55 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 32-38 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-19, 21-31, 40-50 and 52-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15, 32-38 and 51 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

This is in response to Papers filed on 22 October 2007.

I. There has been on the record in the Office action mailed on 29 January 2007 that:

“Applicants’ elect the invention of Group III, claims 16-31 and 39-50 without traverse on 18 December 2006 being acknowledged. There are two groups of claims (16 and 20-31) and (17-19 and 39-50). The record shows that they are not considered to be patentably distinct. Therefore, no restriction in between them is made. Accordingly, no separate consideration or search will be made. However, applicants should disagree, urge, show provide an evidence to the contrary for the record in the next response to this Office action in order for it to be considered timely. The evidence as urged and/or admission as stated on or for the record will be used to make a restriction in between two group of the claims in the next Office action.”

II. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-19, 21-31, 40-50 and 52-55 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lambert (6,232,026).

Lambert discloses and teaches a resin coated carrier core. The core comprises more than two groups of metal oxides, especially with one or more metal oxide groups of  $\text{TiO}_2$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  as newly amended by applicants on 01 June 2007. At the level of one skilled in the art, at least a part of one or more metal oxide groups of  $\text{TiO}_2$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  are independently as a part in a core of the resin coated carrier by Lambert processing steps of making the resin coated carrier core. Please see the whole disclosure of the applied reference, especially at least col.5:31-45, 6:18-28, 8:53 to 9:22, Examples 1-4, 9-12 and 33-36. Since a part of a patentability of the claims are on the newly inserted embodiment of "a part of...independently present...", applicants are requested to early provide an evidence to the contrary as pointed out and set forth on the record for the patentability of the claims because an allowed claims

or patent would have no value when someone shows that Lambert teachings and/or suggestion would reasonably and/ or obviously about have at least one molecule of  $\text{TiO}_2$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  is independently presenting the carrier core. Arguments alone may have and are given a little value since they are not a factual evidence for a patentability of the claimed embodiments. The language "melting point of not higher than  $1000^\circ\text{C}$ " "melting point of not lower than  $1800^\circ\text{C}$ " or "electrical resistivity...", "Hc of ...not more than 50 Oe" or the like is a functional property or a measurement of a functional property of a material and considered inherent. For a patentability of a functionally claimed property embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same or obviously about the same functionally claimed property embodiment as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In the absence of a showing of a convincing evidence to the contrary as clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Lambert.

In an alternative, a reasonable teachings and suggestions in the applied references are also reasonably found to be rendered prima facie obvious by Lambert.

III. Claims 54-55 are rejected under 35 U.S.C. 103(a) as obvious over Lambert (6,232,026) considered in view of Meyer et al (2003/0207193).

Lambert discloses and teaches a resin coated carrier core. The core comprises more than two groups of metal oxides, especially with one or more metal oxide groups of  $\text{TiO}_2$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  as newly amended by applicants on 01 June 2007. At the level of one skilled in the art, at least a part of one or more metal oxide groups of  $\text{TiO}_2$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  are independently as a part in a core of the resin coated carrier by Lambert processing steps of making the resin coated carrier core. Please see the whole disclosure of the applied reference, especially at least col.5:31-45, 6:18-28, 8:53 to 9:22, Examples 1-4, 9-12 and 33-36. Since a part of a patentability of the claims are on the newly inserted embodiment of “a part of...independently present...”, applicants are requested to early provide an evidence to the contrary as pointed out and set forth on the record for the patentability of the claims because an allowed claims or patent would have no value when someone shows that Lambert teachings and/or suggestion would reasonably and/ or obviously about have at least one molecule of  $\text{TiO}_2$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  is independently presenting the carrier core. Arguments alone may have and are given a little value since they are not a factual evidence for a patentability of the claimed embodiments. The

language “melting point of not higher than 1000°C” “melting point of not lower than 1800°C” or “electrical resistivity...”, “Hc of ...not more than 50 Oe” or the like is a functional property or a measurement of a functional property of a material and considered inherent. For a patentability of a functionally claimed property embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same or obviously about the same functionally claimed property embodiment as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference.

Lambert does not specify a core that may or would contain a soft magnetic ferrite agent. However, it is known in the art at the time the invention was made to obtain and use a soft magnetic ferrite agent for the advantage of obtaining low remanance or reducing magnetic saturation and lower coercivity value as compared to the use of a hard magnetic agent alone. Evidence, can be seen in at least Meyer et al (2003/0207193 at least paragraph 0084. In the absence of a showing of a convincing evidence to the contrary as clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Lambert.

Since the above applied references are all related to magnetic carrier core containing known magnetic agents, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cite the known use a soft magnetic agent for a reasonable expectation of obtaining low remanance or reducing magnetic saturation and lower coercivity value as compared to the use of a hard magnetic agent alone as disclosed, taught and suggested Meyer et al.

IV. Applicant's arguments filed 22 October 2007 have been fully considered but they are not persuasive.

Applicants point out that Lambert does not specify a core that may or would contain a soft magnetic ferrite agent. However, it is known in the art at the time the invention was made to obtain and use a soft magnetic ferrite agent for the advantage of obtaining low remanance or reducing magnetic saturation and lower coercivity value as compared to the use of a hard magnetic agent alone. Evidence, can be seen in at least Meyer et al (2003/0207193 at least paragraph 0084.

Applicants fail to recognize that the language "melting point" or the like as urged is a property of material. Therefore, the arguments have and are given a

little patentable value since they are not a factual evidence as clearly pointed out and set forth time after time during the prosecution of this application.

Applicants urge that Lambert does not teach or suggest one or more metal oxide groups of  $\text{TiO}_2$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  are independently as a part in a core of the resin coated carrier in response the amendment to claims 16 and 17 filed on 22 October 2007. At the level of one skilled in the art, at least a part of one or more metal oxide groups of  $\text{TiO}_2$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  are independently as a part in a core of the resin coated carrier by Lambert processing steps of making the resin coated carrier core. Please see the whole disclosure of the applied reference, especially at least col.5:31-45, 6:18-28, 8:53 to 9:22, Examples 1-4, 9-12 and 33-36. Since a part of a patentability of the claims are on the newly inserted embodiment of "a part of...independently present...", applicants are requested to early provide an evidence to the contrary as pointed out and set forth on the record for the patentability of the claims because an allowed claims or patent would have no value when someone shows that Lambert teachings and/or suggestion would reasonably and/ or obviously about have at least one molecule of  $\text{TiO}_2$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  is independently presenting the carrier core. Arguments alone may have and are given a little value since they are not a factual evidence for a patentability of the claimed embodiments.

V. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-19, 21-31, 40-50 and 52-55 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ikeda et al (2003/0122918).

Ikeda et al disclose and teaches a resin coated carrier core. The core comprises more than two groups of metal oxides, especially with one or more metal oxide groups of  $\text{TiO}_2$  and  $\text{ZrO}_2$ . At the level of one skilled in the art at least one or more metal oxide groups of  $\text{TiO}_2$  and  $\text{ZrO}_2$  are independently as a part in a core by Ikeda et al teachings and/or suggestion with a presence of one or more  $\text{TiO}_2$  and  $\text{ZrO}_2$  in a mixture form with metallic-compound particles on at least paragraphs 0071, 0072 and 0116. Since a part of a patentability of the

claims are on the newly inserted embodiment of “a part of...independently present...”, applicants are requested to early provide an evidence to the contrary as pointed out and set forth on the record for the patentability of the claims because an allowed claims or patent would have no value when someone shows that Ikeda et al teachings and/or suggestion would reasonably and/or obviously about have at least one molecule of  $\text{TiO}_2$  and  $\text{ZrO}_2$  is independently presenting the carrier core. Arguments alone may have and are given a little value since they are not a factual evidence for a patentability of the claimed embodiments. For further details, please also see the whole disclosure of the applied reference, especially at least paragraphs 0056, 0061, 0066 to 0072, 0115, 0116, 0247 The language “melting point of not higher than  $1000^\circ\text{C}$ ” “melting point of not lower than  $1800^\circ\text{C}$ ” or “electrical resistivity...”, “Hc of ...not more than 50 Oe”, “soft ferrite material” or the like is a functional property or a measurement of a functional property of a material and considered inherent. For a patentability of a functionally claimed property embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to

the same or obviously about the same functionally claimed property embodiment as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In the absence of a showing of a convincing evidence to the contrary as clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Ikeda et al .

In an alternative, a reasonable teachings and suggestions in the applied references are also reasonably found to be rendered prima facie obvious by Ikeda et al.

VI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be

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obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

**HOA VAN LE**  
**PRIMARY EXAMINER**

HVL  
07 November 2007

*Hoa Van Le*